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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,807	07/10/2002	Werner Wagner	ADVA:002	8442
7590	03/24/2005		EXAMINER	
Robert M O'Keefe O'Keefe Egan & Peterman Building C Suite 200 1101 Capital of Texas Highway South Austin, TX 78746			STEPHENS, JACQUELINE F	
			ART UNIT	PAPER NUMBER
			3761	
DATE MAILED: 03/24/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

SN

<b>Office Action Summary</b>	<b>Application No.</b> 09/980,807	<b>Applicant(s)</b> WAGNER ET AL.	
	<b>Examiner</b> Jacqueline F Stephens	<b>Art Unit</b> 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/11/02, 9/17/03</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the multi-layer lower side must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 4, 5, 6, 8, 11, 13-16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Butterworth et al. USPN 3967623.

Claim 1: See Figures 2-4, col. 2, line 62 through col. 3, line 1. The limitations regarding how the nap is provided are directed to a process of making the article.

“Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

Claim 2: see col. 2, lines 19-31.

Claim 4: see Figure 4.

Claim 5: see Figure 4.

Claim 6: see Figures 2-4.

Claim 8: see col. 1, lines 62-66 and col. 2, lines 24-47.

Claim 11: Regarding the limitations of "the fibrous web of the lower side (20) makes it possible to fix the hygiene product on a contact surface", these limitations are directed to an intended use of the article. Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). If the prior art structure is capable of performing the intended use, then it meets the claim limitations. The invention of Butterworth has fibrils on the web surface, which is capable of aiding fixing the hygiene product on a contact surface as broadly as claimed.

Claims 13-16: see col. 5, lines 26-34.

Claim 18: regarding the composition of the film, see col. 2, lines 62 through col. 3, line 1; col. 4, lines 3-11. Regarding the limitations of working the fibers through the web, these limitations are directed to an intended use of the article. Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). If the prior art structure is capable of performing the intended use, then it meets the claim limitations. The invention of Butterworth has fibrils on the web surface, which is capable of aiding fixing the hygiene product on a contact surface as broadly as claimed.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 3, 7, 17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butterworth USPN 3967623.

As to claim 3, see the discussion of claim 1 supra. Applicant claims a multi-layered non-perforated film, which Butterworth does not teach. Butterworth does teach a single layer non-perforated film (Figure 3) for the purpose of wicking fluids to the underlying core. It would have been an obvious matter of design choice to use a multi-layer film, since applicant has not disclosed that the multi-layered film solves any stated

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problems or is for any particular purpose and it appears that the invention would perform equally well with the single layer nonperforated film.

As to claims 7, 17, 19, and 20, Butterworth discloses fibril length of  $\frac{1}{4}$  inches or less. Butterworth does not teaches the claimed length. However, Butterworth teaches the facing sheet provided with surface fibers in the same field of endeavor, in absorbent articles for providing a tactile feel to the absorbent product. Therefore to provide the article of Butterworth with the claimed fiber length would have been obvious and this modification is within the capabilities of one of ordinary skill in the art. More particularly, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation, *In re Aller* et al, 105 USPQ 233.

7. Claims 10, and 22-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butterworth in view of Heinzireiter EP 0899086.

Claims 22, 25, and 26: Butterworth discloses withdrawing the fibers (col. 3, lines 48-62), but does not disclose cooling by calendering. Heinzireiter discloses cooling by calendaring see Abstract, col. 2, lines 18-45; col. 3, lines 25-29 to affect the elongation and extent of damage of the respective projections. It would have been obvious to modify the process of Butterworth to include cooling by calendaring as taught in Heinzireiter to be able to modify the degree of elongation and damage to the fibers.

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Claims 10, 23 and 24: Butterworth/Heinzireter do not specifically teach the extent the naps are stretched. However, Heinzireter discloses cooling by calendaring see Abstract, col. 2, lines 18-45; col. 3, lines 25-29 to affect the elongation and extent of damage, which can affect the shape, of the respective projections. Heinzireter, therefore recognizes the elongation is a result effective variable of the heating or cooling process. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Butterworth/Heinzireter with the claimed elongation and shape, since discovering an optimum value of a result effective variable involves only routine skill in the art. See Heinzirete paragraph 0019, where craters are disclosed.

Claims 21, 30, 31: see Butterworth col. 4, lines 12-57, where he discusses different methods and see Heinzireter paragraphs 0016-0022, particularly 0019, where Heinzireter discusses different shapes and surface irregularities.

Claim 27: see Figures 2-4 of Butterworth

Claim 28: see Figure 4, col. 5, lines 26-34.

Claim 29: see Figure 3.

Claim 32: see Heinzireter col. 3, lines 17-21 where he discusses disengaging the sheet from the roll.

Claim 33: see Heinzireter col. 3, line 13-17.

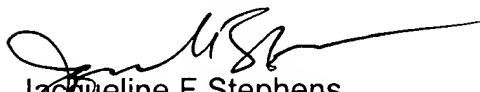


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on (571)272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jacqueline F Stephens  
Examiner  
Art Unit 3761

March 21, 2005